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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,345	03/01/2004	Carla Schaefer	159.1.1355	9394
7590 09/20/2005 WATOV & KIPNES, P.C. P.O. Box 247 Princeton Junction, NJ 08550			EXAMINER COLLINS, DOLORES R	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/790,345	SCHAEFER ET AL.	
	Examiner	Art Unit	
	Dolores R. Collins	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-9 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 6 & 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of Species I, covered by Figures 1 and 2 with claims 1-5, 7-9 & 13-16 readable thereon, in the reply filed on 6/17/05 is acknowledged. Claims 6 & 10-12 are considered withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9 & 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollard (815) in view of Hopkins et al. (533).

Pollard discloses an Instant Bingo Game And Game Card Therefor.

Regarding claim 1

Claim 1 is simply a conventional scratch and win ticket where the indicia is in puzzle shapes with indicia thereon. The claimed invention is simply a conventional scratch and win ticket except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). Pollard discloses a functionally similar device. It would have been obvious to one having ordinary

skill in the art at the time the invention was made to use any type since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Further, the simple idea of matching pieces, whether a puzzle piece, character, number or any form of indicia lends no patentable features and would be obvious to the ordinary skilled artisan to simply select any functional indicia with the Pollard device.

Alternatively, Hopkins is used to illustrate the teaching of a jig-saw lottery system. Hopkins discloses a Multiple Jig-Saw Puzzle promotional Lottery Game And method Of Playing Same. Hopkins teaches a lottery game with a first play area having a plurality of jig-saw type puzzle pieces (see 10) and a second play area (18) having at least one play region (16 & 16a) with pieces in a pattern (i.e., two straight lines). Hopkins further teaches that his game is executed by the

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removal of puzzle pieces which when matched with the first play area wins a prize (see claim 1).

Regarding claim 2

Hopkins teaches that his game is executed by the removal of puzzle pieces which when matched to a board in the first play area (see figures 1 & 2 and claims 1 & 2).

Regarding claim 3

Hopkins teaches a puzzle board that has cavities and complements necessary for fitting a jigsaw puzzle together (see figure 2).

Regarding claim 4

Hopkins teaches a lottery ticket with a first play area having a plurality of jigsaw type puzzle pieces (see 10) and a second play area (18) having at least one play region (16 & 16a).

Regarding claim 5

Hopkins teaches a lottery ticket with a first play area having a plurality of jigsaw type puzzle pieces in individual spaces (see 10).

Regarding claim 7

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Hopkins teaches a lottery ticket with a second play area (18) having at least one play region (16 & 16a). Hopkins fails to teach that the number of pieces per region is different. Bachman teaches two play regions. Bachman further teaches puzzle pieces of unequal numbers in his play region (see figure 24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hopkins to include an unequal number of pieces per play region to add an element of mystery to game play.

Regarding claims 8 & 9

Hopkins fails to teach a removable scratch off layer. Bachman discloses a Promotional Article With Pressure-Sensitive Adhesive Portions And Method Of Manufacture.

Bachman teaches a first area with removable portions and the ability to scratch off a layer (see col.7, lines 7-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hopkins to include a removable layer that may be scratched off to add an element of mystery to game play.

Regarding claims 13-15

Hopkins teaches a lottery ticket with a first play area having a plurality of jig-saw type puzzle pieces (see 10) and a second play area (18) having at least one play region (16 & 16a) with pieces in a pattern (i.e., two straight lines).

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Regarding claim 16

Hopkins teaches that his puzzle pieces have "visual indications" on their faces (see col. 2, lines 53-55).

Response to Arguments

Applicant's arguments filed 2/2/05 have been fully considered but they are not persuasive. Applicant has amended independent claim 1 to include language that the current references overcome. Further, the addition of claims 14-16 fail present novelty over the cited references of art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited to show the state of art with respect to features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Dolores R. Collins*** whose telephone number is **(571) 272-4421**. The examiner can normally be reached on 8.00 A.M. - 4:30 P.M..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ***Greg Vidovich*** can be reached on **(571) 272-4415**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).



8/30/05


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